

**REMARKS**

The Final Office Action mailed May 27, 2004, has been carefully considered. The present Amendment is intended to be a complete response thereto and to place the case in condition for allowance.

Claims 11-18 are pending. Claims 1-10 have been cancelled. Claims 11 and 17 have been amended.

THE CLAIMS ARE NOT OBVIOUS

Claims 11-12, 14, and 16 stand rejected under 35 U.S.C. § 103(a) as being obvious over Tamura et al. (U.S. Patent No. 5,492,792). Claims 11-12, 14, and 16 stand rejected under 35 U.S.C. § 103(a) as being obvious over Tamura et al. in view of Sasakawa et al. (U.S. Patent No. 5,283,094). Claims 11-12, 14, and 16 stand rejected under 35 U.S.C. § 103(a) as being obvious over Tamura et al. in view of Sasakawa et al., and further in view of Sato et al. (U.S. Patent No. 4,752,554). Claims 11-18 are rejected under 35 U.S.C. § 103(a) as being obvious over Tamura et al. in view of Sasakawa et al., and further in view of Sato et al. and Suzuki (U.S. Patent No. 4,904,574). Applicant respectfully traverses the rejections.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP 2143.

The references, taken alone or in combination, fail to disclose every element of the claimed invention. In particular, the references fail to disclose that the information/recording layer(s) is transparent. The claims have been amended to recite that “said at least one information layer is transparent.” It is clear from the specification that the layers of the fluorescent media should be transparent for reading/writing with a laser beam.

Contrary to the claimed invention, the cited references are drawn to reflective-type media, which use reflective (non-transparent) information layer(s). For example, in column 27, lines 20-23, Tamura et al. specifically states that “[t]he thickness of the recording layer (2) is preferably as small as possible so long as a thin film having sufficient reflectance for a recording laser beam can be stably formed” (emphasis added).

Sasakawa et al. also disclose a reflective layer in their recording media. In column 2, lines 24-30, Sasakawa et al. disclose a “recording layer containing ... a reflective layer...” (emphasis added). Also, in column 7, lines 26-30, Sasakawa et al. disclose that “[u]pon forming the recording layer, the thickness of the recording layer is adjusted to obtain sufficient reflectivity after forming a reflective layer” (emphasis added). The disclosure of reflecting recording layer(s) clearly shows that neither Tamura et al. nor Sasakawa et al. contemplated the use of transparent recording layer(s) as recited by the present claims.

Moreover, by teaching reflecting recording layers, both Tamura et al. and Sasakawa et al. not only fail to disclose a transparent recording layer of the present invention, but specifically teach away from the present invention. In the present case, modification of the references to arrive at the invention would render the applied references (Tamura et al. and

Sasakawa et al.) unsatisfactory for their intended purpose. Therefore, there is no motivation or suggestion to modify the references to arrive at the present invention. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984); *see also* MPEP 2143.01.

Further, the references fail to disclose an adhesive that prevents the “formation on an inter-layer boundary of non-fluorescent poly-molecular associates of fluorescent dyes causing quenching of fluorescence.” The present application relates to an optical memory disc that is read by means of fluorescence. In using the optical memory disc of the present invention, a laser is used to read the disc. The disc fluoresces in response to the laser and information is gathered by reading the emitted fluorescence.

Tamura et al. do not teach an adhesive that prevents quenching of fluorescence. In column 27, lines 30-53, Tamura et al. teach an undercoat layer for various purposes, including for improving adhesion between the substrate and the recording layer; however, Tamura et al. fail to disclose that the adhesion is such that it prevents formation, on an inter-layer boundary, of non-fluorescent poly-molecular associates of fluorescent dyes that cause quenching of fluorescence. Any adhesive will do for Tamura et al. On the other hand, the present invention requires an adhesive that prevents fluorescence quenching.

As previously mentioned, the Tamura et al. recording layer is a reflective-type media which does not use fluorescence reading. Therefore, Tamura et al. could not have contemplated the use of an adhesive that prevents the “formation on an inter-layer boundary of non-fluorescent poly-molecular associates of fluorescent dyes causing quenching of fluorescence,” because such an adhesive would not be advantageous or desired over other

adhesives when used with the reflective-type media of Tamura et al. Moreover, this deficiency is not satisfied by Sasakawa et al., Sato et al., and Suzuki, so that the combined references would not have resulted in the present claimed invention.

In the Final Office Action, the Examiner states that “[t]here may be a criticality to the materials providing the adhesion and preventing aggregation as argued by the applicants, but data supporting such an assertion is not in the record” (emphasis original). Applicants respectfully submit that the importance of the adhesive for preventing “formation on an inter-layer boundary of non-fluorescent poly-molecular associates of fluorescent dyes causing quenching of fluorescence” is repeatedly emphasized in the specification (the record). *See, e.g.*, page 4, lines 12-19; page 5, lines 3-10; and page 6, lines 1-10.

Therefore, for the reasons noted, the claims are not obvious within the meaning of 35 U.S.C. § 103. Accordingly, Applicants respectfully request the withdrawal of the rejections.

## CONCLUSION

Applicants have responded to the Office action mailed May 27, 2004. All pending claims are now believed to be allowable and favorable action is respectfully requested.

In the event that there are any questions relating to this Amendment or to the application in general, it would be appreciated if the examiner would telephone the undersigned attorney concerning such questions so that the prosecution of this application may be expedited.

*Alperovich et al.*  
*Serial No. 09/493,818*

Please charge any shortage or credit any overpayment of fees to BLANK ROME LLP, Deposit Account No. 23-2185 (109289-00121). In the event that a petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this response, Applicants hereby petition under 37 C.F.R. 1.136(a) for an extension of time for as many months as are required to render this submission timely.

Any fees due are authorized above.

Respectfully submitted,

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